

## **REMARKS**

### **I. General**

Claims 1-24 are pending in the present application. The outstanding issues raised by the Examiner in the current Office Action are as follows:

- Claims 17-24 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- Claims 1-5, 7-13, 15-21, 23, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0107830 to Nanja (hereinafter *Nanja*) in view of U.S. Patent Application Publication No. 2004/0176085 to Phillips et al. (hereinafter *Phillips*); and
- Claims 6, 14, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nanja* in view of *Phillips*, and further in view of U.S. Patent Application Publication No. 2004/0199635 to Ta et al. (hereinafter *Ta*).

In response, Applicant respectfully traverses the outstanding claim rejections and requests reconsideration and withdrawal in light of the remarks presented herein.

### **II. Amendments to the Specification**

Paragraph [0001] of the Present Specification has been amended to include the serial numbers of cross-referenced related applications. Accordingly, no new matter is presented.

### **III. Claim Rejections Under 35 U.S.C. § 101**

Claims 17-24 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Office Action, page 2. Applicant respectfully disagrees. Claim 17 recites, in part, “[a] computer program product having a computer readable medium with computer program logic recorded thereon for developing information for a mobile information system . . .” Under § 101,

“[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new

and useful improvement thereof, may obtain a patent therefor . . .”

35 U.S.C. § 101. Applicant is not aware of any reason why claims 17-24 would not be patentable under § 101. Also, the Examiner has not explained why these claims are believed to be directed to non-statutory subject matter. *See* Office Action, page 2.

Applicant points out that the Manual of Patent Examining Procedure contains Guidelines for interpreting the requirements of 35 U.S.C. § 101. The Guidelines expressly provide that:

[i]f a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in term of its hardware or hardware and software combination, it defines a statutory product.

M.P.E.P. § 2106(IV)(B)(2)(a). Here, the claims clearly recite a useful machine or manufacture (*i.e.*, computer program product) and identify the physical structure of the machine or manufacture in terms of hardware and software combination (*i.e.*, a computer readable medium with computer program logic recorded thereon). Moreover, it has long been accepted that computer programs embodied in a tangible medium are patentable subject matter under 35 U.S.C. § 101. *See In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). Accordingly, Applicant asserts that claims 17-24 define a statutory program product claim, and respectfully requests that the Examiner withdraw the 35 U.S.C. § 101 rejection with respect to these claims.

#### **IV. Claim Rejections Under 35 U.S.C. § 103 Over *Nanja* and *Phillips***

Claims 1-5, 7-13, 15-21, 23, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nanja* in view of *Phillips*. Office Action, page 2. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the references relied upon must be analogous prior art. M.P.E.P. § 2141.01(a). In other words, the references “must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” *In*

*re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992), *cited in* M.P.E.P. § 2141.01(a). In addition, three other criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicant asserts that the rejection does not satisfy these basic criteria.

A. Non-Analogous Prior Art

In rejecting claims 1-5, 7-13, 15-21, 23, and 24, the Office Action relies, in part, upon *Phillips*. Office Action, page 2. Applicant respectfully asserts that *Phillips* is non-analogous prior art. In fact, the Examiner has not contended that *Phillips* is in the field of Applicant's endeavor. *See* Office Action, pages 2-3.

Claims 1-5, 7-13, 15-21, 23, and 24 are directed to systems and methods for providing data for mobile information systems. Specification, paragraph [0002]. Meanwhile, *Phillips* discloses a fixed interface between a service providers' network and a customer's premises. *Phillips*, paragraphs [0002]-[0004]; Figure 1A. Therefore, *Phillips* is non-analogous art because its general scope is outside the pertinent field of endeavor of the present invention and because the subject matter disclosed in *Phillips* is irrelevant to the particular problem with which the present inventor is involved. *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069 (Fed. Cir. 2003), *cited in* M.P.E.P. § 2141.01. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claims 1-5, 7-13, 15-21, 23, and 24.

B. Lack of Motivation

Claims 1-5, 7-13, 15-21, 23, and 24 are allowable because there is no suggestion or motivation to combine the data distribution system described in *Nanja* with the network interface system of *Phillips*. The Office Action states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of [*Phillips*] into the teachings of [*Nanja*] for the purposes of increasing efficiency." Office

Action, page 3. First, Applicant asserts that there is no need to “increase the efficiency” of *Nanja*’s system and that there is no indication, either in *Phillips*, *Nanja*, or in the knowledge generally available to a person of ordinary skill in the art, that *Phillips*’ network interface device would indeed “increase the efficiency” of *Nanja*’s system.

Second, Applicant asserts that *Nanja*’s system was designed to distribute data to wireless handheld devices, whereas *Phillips*’ network interface is fixed between a telecommunications service provider and consumer premises equipment. Therefore, adding *Phillips*’ fixed network interface device into *Nanja*’s mobile system would require an improper substantial reconstruction and redesign of the elements shown in *Nanja*, as well as a change in the basic principle under which *Nanja* was designed to operate. *See In re Ratti*, 270 F.2d 810, 843, 123 USPQ 349, 352 (CCPA 1959). If the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims obvious. M.P.E.P. § 2143.01. Additionally or alternatively, adding *Phillips*’ fixed network interface device to *Nanja*’s mobile system would render *Nanja* unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. M.P.E.P. § 2143.01.

Third, the Examiner has not provided an objective reason to combine the teachings of the references. *See* M.P.E.P. § 2142.01. The motivation put forth by the Office Action—*i.e.*, “increasing efficiency,” is merely a general incentive, and not an objective reason to combine the references. It has long been held that “[a] general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out.” *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). Therefore, the motivation for the combination of *Nanja* and *Phillips* is improper. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 1-5, 7-13, 15-21, 23, and 24.

C. Lack of All Claimed Limitations

Independent claim 1 recites, in part, “aggregating said information preferences . . . .” Independent claims 9 and 17 recite similar limitations. The Examiner admits that *Nanja* does not meet these limitations, and relies upon *Phillips* as teaching or suggesting such limitations. Office Action, page 3. The passages of *Phillips* cited to by the Examiner disclose an aggregator that:

can aggregate non-POTS information sets received from processing system 244 and POTS information sets received directly from discrimination device 232 for consolidated transmission . . . .”

*Phillips*, paragraph [0082]. Further, the “information” aggregated by *Phillips*’ system only comprises “video, broadcast video, video on demand, audio, audio on demand, Internet, point-to-point data transmission, point-to-point virtual private circuit and voice” signals. *Phillips*, paragraph [0006]. Applicant asserts that, while *Phillips* may disclose aggregating “a plurality of sets of telecommunication information,” it does not teach or suggest aggregating user preferences. *Phillips*, paragraph [0007]. In fact, neither the term “preferences” nor any colorable equivalent appears in *Phillips*’ disclosure. Therefore, the combination of *Nanja* and *Phillips*, even if proper, does not teach or suggest aggregating preferences. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claims 1, 9, and 17.

Dependent claims 2-5, 7, 8, 10-13, 15, 16, 18-21, 23, and 24 depend either directly or indirectly from claims 1, 9, or 17, each dependent claim thus inheriting all the limitations of its respective independent claim. As noted above, the combination of *Nanja* and *Phillips* is improper, as *Phillips* is non-analogous art, but even if considered together, fails to teach or suggest all of the limitations of independent claims 1, 9, and 17. Consequently, the combination of *Nanja* and *Phillips* also fails to teach or suggest all of the limitations of dependent claims 2-5, 7, 8, 10-13, 15, 16, 18-21, 23, and 24. Moreover, each of these dependent claims recite additional limitations not taught or suggested by the applied art. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 2-5, 7, 8, 10-13, 15, 16, 18-21, 23, and 24.

**V. Claim Rejections Under 35 U.S.C. § 103 Over *Nanja*, *Phillips*, and *Ta***

Claims 6, 14, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nanja* in view of *Phillips* and *Ta*. Office Action, page 5. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

**A. Lack of All Claimed Limitations**

Dependent claims 6, 14, and 22 depend from claims 1, 9, and 17, respectively, each dependent claim thus inheriting all the limitations of its respective independent claim. The Examiner admits that the combination of *Nanja* and *Phillips* does not disclose “checking assigned bandwidth limitations for each of said plurality of subscribers; and wherein said sending step comprises: sending subscriber-specific feed data streams to ones of said plurality of subscribers whose assigned bandwidth limitations has not been exceeded,” and relies upon *Ta* as meeting those limitations. Office Action, page 5.

As noted above, the combination of *Nanja* and *Phillips*, even if proper, fails to teach or suggest all of the limitations of independent claims 1, 9, and 17. Applicant asserts that *Ta* does not cure those deficiencies, and the Examiner has not shown otherwise. Hence, the combination of *Nanja* with *Phillips* and *Ta* fails to teach or suggest all of the limitations of independent claims 1, 9, and 17. Consequently, the combination of *Nanja* with *Phillips* and *Ta* also fails to teach or suggest all of the limitations of claims 6, 14, and 22. Moreover, each of these dependent claims recite additional limitations not taught or suggested by the applied art. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 6, 14, and 22.

**B. Lack of Motivation**

Claims 6, 14, and 22 are allowable because there is no suggestion or motivation to combine *Ta* with *Nanja* and *Phillips*. The Office Action states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of [*Ta*] into the teachings of [*Nanja*] and [*Phillips*] for the purposes of improved bandwidth allocation . . . .” Office action, page 5. However, there is no indication of a need for “improved bandwidth allocation” in *Nanja* nor *Phillips*. The mere fact that references can

be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01.

In addition, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result—*i.e.*, it is obvious to add a *Ta*'s bandwidth allocation system to *Nanja* and *Phillips* in order to have a bandwidth allocation system in *Nanja* and *Phillips*. Such language is merely a statement that the references can be combined and does not state any desirability for making the combination. Neither the prior art nor the knowledge available to a person of ordinary skill in the art suggest the desirability of the combination, and Applicant asserts that there is no suggestion or motivation to combine *Ta* with *Nanja* and *Phillips*. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 6, 14, and 22.

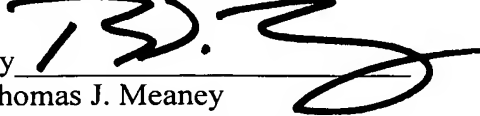
## VI. Conclusion

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 47583/P046US/10316464 from which the undersigned is authorized to draw.

Dated: August 22, 2006

Respectfully submitted,

By 

Thomas J. Meaney

Registration No.: 41,990

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-8000

(214) 855-8200 (Fax)

Attorney for Applicant